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09/396,530 09/15/99 ADDINGTON

R 99-1002

024253
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QM12/0103

EXAMINER

PIERCE, W

ART UNIT	PAPER NUMBER
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 9

Application Number: 09/396530

Filing Date: 9/15/99

Appellant(s): Addington et al.

Joel Rosenblatt
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 10/10/00.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

Art Unit:

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because Appellant's Summary is argumentative and is not limited to the structure of the claimed invention. Examiner's position with respect to these remarks is set forth in the examiner's response to appellant's remarks.

(6) *Issues*

The appellant's statement of the issues in the brief is correct with respect to issues 1 and 3. The drawing requirements of 2 is not an appealable issue and issue 4 is merely an argument made in attempts to overcome the rejection of the claim made under 102(b).

Art Unit:

As such, two issue in this Appeal are whether the claims are adequately supported by the specification under 35 USC 112, first paragraph and whether or not they are anticipated under 102(b) by Marinese.

(7) *Grouping of Claims*

The rejection of claims 14-30 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

3,046,561

Marinese et al

7-1962

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 14-30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification.

Art Unit:

The specification fails to discuss the steps as set forth in claims 14-30. This is a new matter rejection in that the specification fails to provide support for the claims as they are now amended.

2. Claims 14-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Marinese et al.

Marinese shows a finger pad shield 1 in contact with a finger pad of a bowlers finger at 7b. The finger pad shield has a first and second surface at 7b and 3 respectively as shown in fig. 1. Fig. 1 shows inserting the finger pad into a finger hole of a bowling ball. The apparatus of Marinese transmits forces applied by the bowlers fingers to the finger pad and then to the bowling ball to control the release and the lift place on the ball as called for in steps c-f. While these “applying a first force”, “producing a second force” and how these forces interact with the finger pad and the bowling ball are not specifically disclosed, it is noted that in method claims, the prior art anticipates it if the device carries out the method during normal operation . (See MPEP 2112.02). Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. While the discovery of a new use for an old structure based on unknown properties of the structure might be patentable to the discoverer as a process of using. In re Huck , 114 USPQ 161, 163 (CCPA 1957). Such is not the case here since the apparatus of Marinese and the instant invention are being use to transmit forces from a bowlers hand to a bowling ball.

Art Unit:

(11) Response to Argument

3. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Examiners comments with respect to claim 9 are set forth above. While the figure is acceptable it fails to meet the requirements to show each and every feature. While applicant appears to anticipate that this may be a grounds for further objection, he argues in addition that he does not have to use a flow chart to illustrate the claims. The examiner does not require a flow chart. He does require that drawings show every feature of the invention specified in the claims. A flow chart was a suggested way of doing this. Applicant may submit any other way of doing this that he may feel shows the claimed features. Thus, the drawings remain objected to.

Applicant goes on to try and show how the new claims are supported by the specification. Examiner does not agree as set forth in the grounds for rejection above under 35 USC 112, first paragraph. While applicant tries to point where every limitation are generally discussed in the specification, these citation do not support the detailed steps in the claims. For example, the specification does not discuss a "first force" and a "second force. Applicant tries to remedy this by stating (at the top of pg. 16) that how a bowler grips a ball is "generally well known". However, while it is true that one knows how to grip a ball and deliver it, the steps of the claimed invention must be disclosed.

Art Unit:

4. The declarations under 37 CFR 1.132 filed 5/19/00 are insufficient to overcome the rejection of claims 14-30 because they refer only to the invention described in the above referenced application and not to the individual claims of the application. While the declaration does refer to claims, these claim have been canceled an are no longer an issue. Thus, there is no showing that the objective evidence of nonobviousness is commensurate in scope with the claims. See MPEP § 716. The declarations offer the opinions of the inventor and not facts which can be used as basis to overcome the grounds for rejection. In view of the foregoing, when all of the evidence is considered, the totality of the rebuttal evidence of nonobviousness fails to outweigh the evidence of obviousness.

Art Unit:

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in dark ink, consisting of a series of loops and a long horizontal stroke.

wp
January 2, 2001